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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,477 | 11/14/2003 | Takahiro Yagishita | 6453P015 | 1939 |

8791 7590 07/14/2008
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| EXAMINER |
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BLOOM, NATHAN J

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| ART UNIT | PAPER NUMBER |
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2624

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| MAIL DATE | DELIVERY MODE |
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07/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/713,477 | Applicant(s) YAGISHITA ET AL. | |
| | Examiner NATHAN BLOOM | Art Unit 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/08/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response to the last Office Action, filed on April 8th, 2008 has been entered and made of record.

Response to Arguments

1. Applicant's arguments, see pages 13-14 of the Remarks, filed April 8th, 2008, with respect to the 35 U.S.C. 112 second paragraph rejection made in the previous office action have been fully considered and are persuasive. The 35 U.S.C. 112 second paragraph rejection of claims 24-26 has been withdrawn.

2. Applicant's arguments, see pages 14-21 of the Remarks, filed April 8th, 2008, with respect to the newly amended claims 20-46 have been fully considered and are persuasive. The rejections of claims 20-46 has been withdrawn.

In particular, applicant has pointed out that the cited prior art does not teach the use of a non-linear function to determine the quality of the image using the substituted values (number of bits, resolution, number of bit planes, etc....).

However, applicant has also made the argument that the invention (as claimed) requires that the quality information be known prior to the compression of the file, but this language is not currently in the claims.

3. The remainder of the arguments regarding the 35 U.S.C. 103(a) rejections will not be discussed since the rejection of these claims has been withdrawn.

Response to Amendment

4. The prior art rejections of claims 20-46 has been withdrawn due to the current amendment.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of claims 20-46 has introduced new matter in the line that reads as follows: "the picture quality calculated by substituting, into a non-linear function.....". Examiner found no reference, in the provided disclosure, to the use of a non-linear function for calculating picture quality by substitution of a ratio of value (number of bits, planes, resolution, etc.....). Paragraph 0088 of the disclosure does state that a "predetermined function" is used, but no further details of this function have been disclosed by the applicants in the specification. Thus there is no disclosure stating the use of a non-linear function to determine the quality of the image by substituting a value such as the ratio of bits, as is required by claim 20.

Allowable Subject Matter

7. Claims 20-46 would be allowable if the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action are overcome.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Bloom whose telephone number is 571-272-9321. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm (EST).

Art Unit: 2624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehta Bhavesh, can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Brian Q Le/

Primary Examiner, Art Unit 2624